

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the election filed July 22, 2008.

Claims 1-6 were amended and claim 7 was added, rendering claim 1-5 and 7 pending with claim 6 withdrawn as a non-elected invention.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections – 35 USC § 102(b)***

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimose et al. (U.S. 6,203,918).

Shimose discloses a laminate for HDD (hard disk drive) suspension comprising a stainless steel layer, a polyimide layer and a conductor layer wherein the conductor layer is a copper foil or copper alloy foil have a thickness of 3 to 20 $\mu$ m (column 1, line 15-16 and 66 through column 2, line 12; column 5, lines 34-58 and column 6, lines 49-63). Concerning claim 1, because Shimose discloses a laminate for HDD suspension having the same layers as claimed, with the same materials including the copper alloy foil material (80% or more copper and another element such as nickel, silicon, zinc or

beryllium, as defined by Applicant) it is inherent for the conductor layer to have a tensile modulus and conductance as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 633 (Fed. Cir.) (1987).

Concerning claims 2 and 3, the stainless steel base material has a thickness of 10 to 70 $\mu$ m (column 2, lines 8-12) and the thickness of the polyimide layer is 3 to 20 (column 3, lines 1-7). The addition of the ranges of the stainless steel layer, polyimide layer and conductor layer equate to the total thickness of the laminate, as in claim 5.

***Claim Rejections – 35 USC § 103(a)***

4. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimose et al. (U.S. 6,203,918) in view of Manos (U.S. 5,084,345).

Shimose is relied upon for claim 1, as above. Shimose does not disclose the conductor layer as a rolled copper alloy foil, as in claim 4. Manos teaches a multilayer laminate having a steel layer, a polyimide layer and a rolled copper alloy foil (column 13,

lines 41-59). It would have been obvious to one of ordinary skill in the art to substitute the rolled copper alloy foil of Manos for the copper alloy foil of Shimose because Manos teaches rolled copper alloy foils are known in the art and the simple substitution of Manos' rolled copper alloy foil for Shimose's copper alloy foil would achieve the predictable result of enhancing the peel strength of the laminate (column 13, lines 41-59). Applicant argues the instant specification discloses tensile strength of the copper foil or copper alloy foil is not fixed by its composition but is subject to change by the processing of the copper foil or copper alloy foil and varies due to heating. Applicant's arguments appear to be based on the production of the laminate versus the final product. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

### ***Obvious Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 7,338,716 (2004/0067349) in view of Shimose et al (U.S. 6,203,918). Although the conflicting claims are not identical, they are not patentably distinct from each other, because it is obvious to form laminates with stainless steel, for example to form HDD suspensions, as taught by Shimose et al (see discussion above of Shimose) because the laminates are expected to be useful in HDD suspensions because of the similar nature of their layers. Because Patent No. 7,338,716 and Shimose discloses a laminate for HDD suspension having the same layers as claimed, with the same materials including the copper alloy foil material it is expected for the copper alloy foil to have a tensile modulus and conductance as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

### ***Response to Arguments***

7. The rejection made under 35 U.S.C. 112, second paragraph is withdrawn due to Applicant amending 1-5 to define HDD as a hard disk drive.

Applicant's arguments of rejection made under 35 U.S.C. 102(b) as being anticipated by Shimose et al. (U.S. 6,203,918) has been considered but is unpersuasive. Applicant argues none of the cited references, either alone or in combination, teach or suggest all of the limitations of the claims with particular emphasis on the limitations "a tensile strength of 400 MPa or more, and a conductance of 65% or more".

Because Shimose discloses a laminate for HDD suspension having the same layers as claimed, with the same materials including the copper alloy foil material (80% or more copper and another element such as nickel, silicon, zinc or beryllium, as defined by Applicant) it is inherent for the conductor layer to have a tensile modulus and conductance as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 633 (Fed. Cir.) (1987).

Applicant further argues a 1.132 Declaration has been filed by Mr. Yuji Matsusita that clearly establishing that the copper foil disclosed in Shimose does not possess a

tensile strength of 400 MPa or more and a conductance of 65% or more. The Declaration considers two kinds of copper foil used in the Examples, which is an electrolytic copper foil product CF-T9 with a thickness of 9 $\mu$ m and an 18 $\mu$ m thick copper alloy foil product, where catalogs from the copper manufacturers were found. The submitted declaration has been carefully considered. Although the declaration provides support for the tensile strength and conductance of the copper alloy foil, it does not take into consideration the varying thickness of the conductor layer as in column 5, lines 40-45, which varies from 5 to 18 $\mu$ m. As the thickness of the conductor layer varies, it may be possible for the tensile strength and conductance of the layer to vary as well. Because only the thickness of the copper alloy material examples have been considered and not the tensile strength of the layer at the disclosed thicknesses have been considered, it appears the instant declaration is insufficient.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Shimose et al. (U.S. 6,203,918) in view of Manos (U.S. 5,084,345) has been considered but is unpersuasive. Applicant argues the rolled copper alloy foil of Manos does not satisfy the requirements of the claims based on the material used in Example 9 of the disclosure. Although the declaration provides support for the tensile strength and conductance of the copper alloy foil of Example 9 of Manos, it does not take into consideration the copper alloy material of the conductor layer of the entire disclosure. Based upon the entire disclosure, it may be possible for the tensile strength and conductance of the layer to vary.

Applicant's arguments of rejection made on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 7,338,716 (2004/0067349) in view of Shimose et al (U.S. 6,203,918) have been considered but are unpersuasive. Applicant argues the cited art does not teach or suggest "a tensile strength of 400 MPa or more, and a conductance of 65% or more". Because Patent No. 7,338,716 and Shimose discloses a laminate for HDD suspension having the same layers as claimed, with the same materials including the copper alloy foil material it is expected for the copper alloy foil to have a tensile modulus and conductance as claimed. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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